



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.                      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/748,105                           | 12/27/2000  | Scott R. Jeffrey     | 19482.0002          | 4144             |
| 23517                                | 7590        | 03/18/2004           | EXAMINER            |                  |
| SWIDLER BERLIN SHEREFF FRIEDMAN, LLP |             |                      | TRAN, QUOC A        |                  |
| 3000 K STREET, NW                    |             |                      | ART UNIT            |                  |
| BOX IP                               |             |                      | PAPER NUMBER        |                  |
| WASHINGTON, DC 20007                 |             |                      | 2176                |                  |

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/748,105

Applicant(s)

JEFFREY ET AL.

Examiner

Quoc A. Tran

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to application filed 12/27/2000.
2. Claims 1-27 are currently pending in this application. Claims 1, 24, 26 and 27 are independent claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 pages 36 line 15, claim 4 pages 37 line 2, claim 5 pages 37 lines 3-4, claim 15 pages 40 line 2, and claim 25 pages 42 lines 1-2, are rejected under 35 U.S.C. 112, second paragraph, as being Markush format claims, in which the claims are increasingly being used (e.g. "**selected from the group consisting of**"). Use of '**comprising of**' rather than '**consisting of**' in such format are not permitted. For the purpose of Prior Art rejection, the Prior Art normally only needs to teach ONE of the elements in the list following '**consisting of**' to meet the claims limitation. The claims are not allowable simply because of the alternatively claimed elements are not found. See MPEP 2173.05(h).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-6, 8-10, 12-19, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillings et al. US No. 5,666,490 issued 09/09/1997 filed 05/16/1994 (hereinafter '490), in view of Anderson et al. US No. 5,581,682 issued 12/03/1996 filed 06/25/1992 (hereinafter '682).**

6. In regard to independent claim 1, "*developing and storing a cover sheet including a standard set of identification data characterizing each contract*" is taught in '490 col. 7, lines 64-67 through col. 8, lines 1-10; claim 1 also "*generating an index of bookmarks identifying sections of the digital version of each contract*" is taught in '490 col. 2, lines 19-22; claim 1 also "*capturing selected fields of information from the digital version of the contract, the selected fields being selected from a group comprising vendor, contract date, contract expiration date*" is taught in '490 col. 8, lines 1-19; claim 1 also "*organizing and cross-referencing the contracts in a database comprising the captured information and additional information related to each contract, the information in the database being selected from a group comprising reference number, contracting party, vendor, ... , and assets related to contract; alerting designated parties of critical dates associated with each contract*" is taught in col. 8, lines, 1-19; "*and providing remote electronic access to the contracts over the internet*" is taught in '490 col. 4, lines 50-61(i.e. 'The process is implemented by computer software running on network

resources'); claim 1 also *"creating and storing a digital version of each contract by scanning each contract, each digital version comprising a scanned image and a searchable text file"* is taught in '490, col. 9 lines 55-60;

**'490 does not explicitly teaches, "wherein the text is overlaid with the image"** however **'682 teaches**, With an electronic system, an image of the information is captured and stored in digital form by scanning a paper copy of a document or by inputting the information through a keyboard. Once the information is stored, an image of it can be accessed for editing, reviewing or merging with other similar images, or overlaid by other information, see '682 col.1, lines 9-17.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teaching of **'490** with **'682**. One of the ordinary skill in the art would have been motivated to modify this combination to overlay text with the image in the digital version of the scanned contract. The advantage of this modification would enabling users to ***"achieve final form and are stored in the computer system. It is often necessary to be able to review them either on a computer screen or on paper. During reviews it may be desirable to add an annotation to the document or, prior to the review, blank out certain sections (redaction). In both instances, complete fidelity of the original document must be maintained without the inefficiency of making a copy of the document"***, see '682 col. 1, lines 25-33.

**In regard to dependent claim 2** *"assigning each contract a reference number"*, is taught in '490 col. 8, line 2.

**In regard to dependent claim 3** *"generating a cover sheet comprising a plurality of fields each comprising a plurality of members"*, is taught in '490 col. 8, lines 1-10; claim 3 also *"selecting at least one member of each field on the cover sheet; and scanning the cover sheet"* is taught in '490 col. 9, lines 60-67.

**In regard to dependent claim 4**, *"the identification data on the cover sheet is selected from a group comprising... authorized users..."*, is taught in '490 col. 8, lines 1-10 (i.e. 'Assign users to the protocol and define access rights of users').

**In regard to dependent claim 5** *"linking information to the contract, the information selected from the group comprising vendor information..."*, is taught in '490 col. 2, lines 30-35 (i.e. 'Linking the database record with its source image enables the image to be subsequently retrieved directly from the database').

**In regard to dependent claim 6** *"limiting access and extent of access of users to the contracts and related information"*, is taught in '490 col. 7, lines 3-17 (i.e. 'workgroup can access items in a given workflow queue... Access the workflow items is made via the workflow queue').

**In regard to dependent claim 8**, *"searching the contracts"*, is taught in '490 col. 10, lines 21-27 (i.e. 'a Document indexing is the process of associating identifying information with each image. The index information is used to track "active" images in the workflow during processing').

**In regard to dependent claim 9** *"displaying a contract attribute search page comprising lists of alternatives for each member of the standard set of identification data"*, is taught in '490 col. 8, lines 30-37(i.e. 'indexing/tracking table'); also *"selecting*

*at least one alternative for each member of the standard set of identification data "* is taught in '490 col. 10, lines 35-40(i.e. 'Double entry keying of document index information can be used to insure the accuracy of the index information. The documents are first indexed through a batch index process and then routed to an index validation queue where the index information is validated), also, "*initiating the search*" is taught in '490 col. 10, line 40(i.e. ' to initiate indexing').

**In regard to dependent claim 10,** "*the lists are displayed as pull down menus*", is taught in '490 col. 10, line 53 (i.e. 'pull-down lists').

**In regard to dependent claim 12,** incorporate substantially similar subject matter as cited in claims 1, 3, 9 and is similarly rejected along the same rationale.

**In regard to dependent claim 13** "*displaying a list of categories of contract information; selecting a category; and displaying contracts that fall within the selected category*", is taught in '490 col. 8, lines 55-67 through col. 9, lines 1-10. (i.e. 'the system-defined fields are default fields used in every protocol. Some system-defined fields are modifiable, others are not. The system-defined fields are shown in Table 1').

**In regard to dependent claim 14** "*selecting one of the displayed contracts; and displaying information about the selected contract*", is taught in '490 col. 11, lines 43-49 (i.e. 'The CRF page being edited is displayed in the document window 24. The edit operator reviews the CRF page for completeness and clarity. If necessary, clarification annotations are added to the document').

**In regard to dependent claim 15,** incorporate substantially similar subject matter as cited in claim 1, and is similarly rejected along the same rationale.

**In regard to dependent claim 16** “ *wherein the displayed information comprises a contract page comprising cover sheet including information from the database of information concerning the contract, the cover sheet including links to other information in the contract database* ”, is taught in '490 col. 2, lines 30-35 (i.e. 'Linking the database record with its source image enables the image to be subsequently retrieved directly from the database').

**In regard to dependent claim 17** “ *wherein the contract page comprises regions displaying a set of fixed contract summary information and a changeable set of information, and* ”, is taught in '490 col. 5, lines 55-57 (i.e. 'After the selection is made, the process screen 26 and document window 24 are displayed. '), also, “ *user actionable regions for changing the changeable information* ”, is taught in '490 col. 6, lines 1-12 (i.e. 'document is then electronically distributed to system users involved in data processing. Each page scanned is routed according to predefined routing schemes based on the index information. ...operator enters data on the CRF page into the scientific database. . data entered by each operator is compared and, if the data matches, it is accepted into the database. If not, the data is rejected until the discrepancy is resolved')

**In regard to dependent claims 18** “ *wherein details regarding information on the contract page may be accessed through active links on the contract page, wherein the active links comprise the information of which details are sought* ”, is taught in '490 col. 8, lines 54-57 through col. 9, lines 1-10. (i.e. 'the system-defined fields are default fields used in every protocol. Some system-defined fields are modifiable, others are not.').



**In regard to dependent claim 21** “ *wherein one of the links is to the digital version of the contract* ”, is taught in ‘490 col. 4, lines 16-18 (i.e. ‘a link is dynamically established between the database record and the image which is the source of the data’).

**In regard to dependent claim 19** “ *predefining a level of access of a user; verifying a name and a password for the user; and permitting the user to access the contracts with the level of access of the user* ”, is taught in ‘490 col. 7, lines 64-67 through col. 8, lines 1-10 (i.e. ‘Define investigator names, IDs, and patient assignments. Assign users to the protocol and define access rights of users’).

**In regard to dependent claim 22** “ *generating a new contract record utilizing a stored contract record as a template* ”, is taught in ‘490 col. 9, lines 15-34 (i.e. ‘the protocol set up involves CRF packet definition...’).

7. **Claims 7, 11, 20, and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gillings et al. US No. 5,666,490 (hereinafter ‘490), in further view of Anderson et al. US No. 5,581,682 (hereinafter ‘682), and in further view of Harris, Jr. et al. US No. 6,144,975 issued 11/07/2000 filed 05/05/1998 (hereinafter ‘975).**

8. **Claim 7 is representing of claims 11, 20, and 23.**

**In regard to dependent claim 7**, incorporate substantially similar subject matter as cited in claims 1,17 and in further view of the following, and is similarly rejected along the same rationale.

" The ability to delete a vendor", is taught in '490 col. 7, lines 58-62 (i.e. 'deleted from the routing scheme, ... This would result in CRF pages being inadvertently dropped from the workflow').

**'490 and '682 does not explicitly teaches, " wherein the access and extent of access are defined by amount of information that a user may access; ability to print contracts and information "** however **'975 teaches**, FRAME 52 is an image recognition engine that is adapted to intelligently review only relevant fields in the image file ..., see '975 col.8, lines 25-38; **'975 also teaches**, the document output can include ... a print media, see '975 col. 1, lines 65-66.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teaching of **'490 and '682 with '975**. One of the ordinary skill in the art would have been motivated to modify this combination, so user can access and extent of access are defined by amount of information that a user may access; ability to print contracts and information that a scanned image and a searchable text file, wherein the text is overlaid with the image, because, ***Sequences of documents in a multi-step transaction are automatically tracked so that responses are carried out in a timely manner and errors are caught quickly. This enables the transaction to be completed quickly. It is a simple programming step to use the information from automated job tracking to spot common errors and bottlenecks in the system. This enables the system to be adjusted and made more efficient very quickly. Another advantage is that documents are printed when they are needed in a "just-in-time" fashion. A client's representative or their***

***customer places a service order and semi-custom-tailored documents are prepared in response with minimal human intervention***, see '975 col. 9, lines 5-20.

**In regard to dependent claim 11** " *displaying a contract search page comprising a contract text keyword search text entry box; entering text in the text entry box; and initiating the search* " is taught in '975 col. 1, lines 54-61(i.e. 'one communication over a selected one of the plurality of document output media. The input component is also adapted to convert the request in each received communication into a service item and to communicate the service items to the processing system, wherein each service item includes a stack of tasks necessary for completing the corresponding request').

**In regard to dependent claim 20**, incorporate substantially similar subject matter as cited in claim 7, and is similarly rejected along the same rationale.

**In regard to dependent claim 23** " *providing remote electronic access over the internet to contracts being negotiated; entry of comments concerning the contracts by users; and providing remote electronic access over the internet to contracts commented on by the users* " is taught in '975 col. 3, lines 65-67 through col. 4, lines 1-13(i.e. 'provides a range of document services to a client, which may be at a remote location... representatives, each selling one or more of the client's services to a subset of the client's customers ... Communications between the client and its customers and potential customers may include mailings, fax communications, e-mail, electronic data and the like.....').

**In regard to independent claim 24**, incorporate substantially similar subject

matter as cited in claims 1-2, 23 and is similarly rejected along the same rationale.

**In regard to dependent claim 25**, incorporate substantially similar subject matter as cited in claim 1 and is similarly rejected along the same rationale.

**In regard to independent claim 26**, is directed to computer program product for performing the method of claims 1-2, 23 and is similarly rejected under the same rationale.

**In regard to independent claim 27**, is directed to system for performing the method of claims 1-2, 23 and is similarly rejected under the same rationale.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Friedman et al. U.S. Patent No. 5,995,959 issued: 11/30/1999 filed: 01/23/1998

Chandra et al. U.S. Pub No. 2002/0138582 A1 issued: 09/26/2002 filed: 09/05/2001

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (703) 305-8781. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

Art Unit: 2176

proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


---

**Quoc A. Tran**

**Patent Examiner**

**Technology Center 2176**

**March 10, 2004**

  
**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**